UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,457	10/11/2001	Gordon T. Brown	47781-7	9832

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Alan G. Towner
Pietragallo, Bosick & Gordon
One Oxford Centre
301 Grant Street, 38th Floor
Pittsburgh, PA 15219

EXAMINER
RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/975,457	BROWN, GORDON T.
		Examiner	Art Unit	
		Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 May 2002 and 05 February 2003.</u>

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>28-120</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>28-120</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Applicant's response of 5-9-02 and 2/5/03 has been received and entered.

Currently claims 28-120 are pending. The examiner has reviewed the prosecution

history to date and contrary to remarks made in the record, the instant examiner does

not find the claims to be allowable for the reasons set forth below. This action will be a

non-final as it contains new grounds of rejection not necessitated by an amendment.

1.   The amendment filed 10-11-01 is objected to under 35 U.S.C. 132(a) because it

introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows:

For claims 28,34,39,44,55,71,93,109, there is more than one limitation that are

considered to be new matter. The limitation of providing standardized codes and having

those codes transmitted to the financial accounting system is new matter. First, with

respect to the standardized codes, there are more than one kind of code disclosed in

the specification as originally filed and none of them are called standardized codes.

One code disclosed is the "code numbers" from the first paragraph of page 5. Nothing

here discusses anything about standardized codes. The only things stated as being

standardized is the menu. On page 4, automatic coding instructions are disclosed but

were not called standardized. Another code disclosed is the code that is put into ATM

machines, point of purchase machines, check reading equipment, etc. (from page 7).

These codes are not disclosed as being standardized. Page 8 discusses that check

face information such as coding is read by check imaging equipment. This code is not

discussed as being standardized. Where does support come from in the specification

for the term "standardized codes". Also not disclosed is that the standardized codes are

part of the transmission to the financial accounting system. The examiner does not see

where support comes from for the limitation of transmitting the standardized codes

along with the record of each transaction. Where does support come from for this

limitation? With respect to the language "at about the time" in line 7 of claim 28, the

specification as originally filed did not use the terminology of "at about". The

specification on page 5 states that the transmission of the transaction data takes place

"at the time of the financial transaction". This is not the same as "at about the same

time". The examiner feels that by adding the language "at about", applicant has

effectively broadened the scope of the disclosure. At about the time of the transaction

could be hours later, whereas at the time of the transaction means at the same time as

best as can be done. Where does support come from in the specification as originally

filed for the language "at about the time"? With respect to the claimed "sorting" step,

where does support come from for this step? The examiner cannot find any discussion

of a sorting step in the specification. It is stated that data is processed, but is this the

same as sorting? Where is the sorting of "the transaction" discussed or disclosed in the

specification as originally filed?

With respect to claims 31,37,42,57,73,95,111, the specification as originally filed

did not disclose "itemization codes". Where does support come from for this language?

The examiner cannot find any discussion about itemization codes and has concluded

that this term is new matter.

With respect to claims 33,38,43,54,92,108, the language "at about the time of" is considered to be new matter for the same reasons as set forth with respect to claim 1.

For claims 44,82,120, the specification as originally filed never disclosed anything about the storage medium being a signal in a carrier wave. This is new matter. The examiner notes that applicant has disclosed that a PC can be used to practice the invention and this inherently includes a storage medium like a hard drive, but this does not provide support for the signal claims and applicant never disclosed anything about a signal as the storage medium. Because applicant never disclosed that the storage medium can be a signal, it is considered to be new matter. Also, applicant never disclosed that the instructions for executing the method of the invention are transmitted to another computer so the only storage medium that inherently would be present in the disclosure is that of the personal computing device disclosed in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 44,82,120, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant is claiming a signal encoded with functional descriptive material. A signal as claimed does not fall into any one of the statutory classes of invention eligible for patent protection and is therefore not eligible for patenting. A signal is not a process under 101 as it is not performing any

steps. A signal is not a composition of matter under 101. A signal is not a machine

under 101 because a signal has no physical structure and itself cannot perform any

useful method. A signal is not an article of manufacture/product because a product is a

tangible article or object and a signal is not.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28-39,44-60,71,73,82,92,93,95,108,109,111,120, are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed

invention. The claims are rejected for the same reasons as set forth in the new matter

objection under 35 USC 132(a). The claims contain new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 28-60,69,70,72,73,78-80,82,83,90,91,93,94,109,110,112-118,120, are

rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

For claims 28,34,39,44,93,109, applicant has claimed an associating step for the standardized codes. What are the codes associated to or with? Nothing has been claimed as far as what the codes are associated with so what does this portion of the claim intend to recite? It is not known what this means. With respect to the "standardized codes" the examiner does not know what this is. This is because there are numerous types of codes disclosed in the specification but none of them are called standardized codes. It is not known what the scope of the term "standardized codes" is. What does this mean? With respect to the "sorting the transaction" limitation, how can one transaction be sorted? You need more than one thing to do any kind of sorting step. What is the scope of the sorting the transaction step (what does it mean)? Also, what structure is covered by the language "means for sorting" in the article claims? Because the specification as originally filed does not disclose any sorting step for a transaction, it then follows that when reciting "means for sorting" it is not known what the scope of this language is. Upon consulting the specification it is not clear as to what structure is covered by this language.

With respect to claim 39, applicant is using means plus function language to define structure to the claimed apparatus. Because it is not known what the standardized codes are, it is also not known what is meant by "means for providing standardized codes". Upon consulting the specification it is not clear as to what structure corresponds to the claimed means for providing the codes. Is this or can it be a person? A human had to come up with the codes initially to enter them into the system. With respect to the means for conducting the transactions, what structure does

this cover? When someone conducts an electronic transaction using a credit card, the

credit card allows the person to conduct a transaction. A cash register also allows the

transaction to occur. It is not clear as to what corresponding structure from the

specification is covered by the "means for conducting" language. With respect to the

means for associating, because no association is even claimed, it is not known what the

scope of this language is. What is the structure from the specification that

accomplishes this step? The examiner does not understand what structure from the

specification is covered by the "means for associating" language. What structure from

the specification is covered by the "means for sorting" limitation? This is not clear.

For claims 34,44,78,82,116,120, the claims specify and require that the

instructions are executed by a processor. Applicant has recited that financial

transactions are conducted through other entities and also claimed is that a record for

each transaction is transmitted to a financial accounting system and then the accounting

system produces a statement. The examiner finds the claim indefinite because in the

preamble of the claim it is recited that a processor executes the steps recited in the

body of the claim. How can it be recited that the processor is conducting the

transactions that are conducted through separate entities? The other entities are

conducting the transaction so how can the processor be claimed as doing this step?

After the data is transmitted to the accounting system, how can the processor possibly

perform the step of sorting the transaction, when the claim specifically requires the

accounting system to do this step? These issues render the claim indefinite.

For claims 45,80,83,118, applicant has recited a "means for providing access to said at least one file of said financial accounting computer". It is not clear as to what structure disclosed in the specification is covered by this language. The specification discusses "passcodes" that are issued to approved agents. That seems to be the only thing that could possibly satisfy the claimed means plus function language; however, a passcode is not a structural component of the financial accounting system and is not even a tangible thing. Because in apparatus claims structure is what is being defined, and because a passcode is not a real world physical and tangible thing, it is not clear as to what structure is defined by the recited means plus function language.

For claims 30,36,41,56,72,94,110, applicant has claimed "financial transaction codes". What is this exactly? The scope of this term is not clear and upon consulting the specification it is not clear what this is. It is possible that this term is referring to the codes that are entered into ATM machines to instruct the machine on how to handle the transactions, but the scope of this claim requires the code to be transmitted with the transaction record, and it does not seem to the examiner that the ATM code is part of the transmission. What is the claimed financial transaction code?

For claims 31,37,42,57,73, what is an itemization code? Since this does not appear on the specification as originally filed it is not clear as to what this is.

For claims 51,53,54,69,70, it is not clear as to how many transaction computers there are. Claim 45 recites a plurality and claims 51,53,54, recite "said financial transaction computer". The language of claims 51,53,54, contradict the language from

claim 45. How many computers are there? The same applies to claim 69 that depends from claim 61.

For claim 53, applicant has claimed a method step and the examiner has interpreted this to be reciting the structure of a communication network. The examiner notes that a network for transferring the data is claimed in claim 45 so what is the communication network of claim 53? Is this the same as the network of claim 45?

For claim 79, the preamble recites "The method of Claim 78" but claim 78 is a claim directed to a computer readable medium. It is not clear as to if the claim is directed to a method or an article of manufacture. Applicant appears to be mixing two different statutory classes of invention which renders the claim indefinite.

For claims 80,118, it is not clear upon consulting the specification as originally filed as to what the scope of "means for establishing at least one file" is intended to recite as far as structure goes. What does this define structurally? The same applies to the "means for establishing data inputs", what structure is defined by this means plus function language? Is the means to establish a credit card, or a cash register at the location of the sales transaction? Is this referring to structure such as a hard drive that allows data inputs to be saved?

For claim 90, applicant has claimed a "means for transferring data inputs..." and it is not clear as to what structure is defined by this language. In the independent claim 83, applicant has recited a network for transferring data inputs. In claim 90, is the "means for transferring data inputs" actually reciting the same network as was already recited in claim 83? If yes, applicant cannot claim the same element twice by two

different names, this would not be proper and would render the claim indefinite. If the "means for transferring" recited in claim 90 is not the recited network of claim 83, then what is the structure that is covered by this language? If the "means for transferring" of claim 90 is not the network of claim 83, then upon consulting the specification for guidance on what this means plus function language is intended to mean, it is found that nothing has been disclosed as far as what this "means for transferring" actually is structurally. The scope of this term is not known.

For claim 91, it is not clear if the recited network is a new network in addition to that of claim 83, or if claim 91 is again reciting the network of claim 83. How many networks are claimed in the scope of claim 91? It appears that the network has already been claimed in claim 83.

For claims 112-114, applicant has recited "said user"; however, claim 99 recites "at least one user". How many users are there being claimed, one or at least one? The examiner believes the recitation of "said user" should be changed to "said at least one user".

For claims 115,117, applicant has referred to "said file". Claims 99 and 116 specifically recite "at least one file". How many files are there? One (said file) or at least one? This is not clear.

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   Claims 28-43,45-81,83-119, are rejected under 35 U.S.C. 102(b) as being

anticipated by Lawlor et al. (5220501).

For claims 28-30,33,34,35,36,38,61-72,77-79,99-110,115,116,117, Lawlor

discloses a method as claimed. The 1st entity is the customer (bank account holder).

The providing of standardized codes is satisfied by the disclosure that "standardized

message protocols" are used in the transmission of the financial information to the

separate accounting system 52 from ATM machines or POS nodes 54. A standard

format for the transaction messages is used to that an ATM of Bank A can communicate

with Bank B. The conducting of transactions through other entities is disclosed in

column 21, line 53 to column 22, line 15 and is also satisfied by the user conducting an

ATM transaction. The transactions are conducted through terminals 54, of which there

are a plurality. The transaction that is conducted includes the transfer of funds or an

instruction for the transfer of funds as claimed. The associating the standardized codes

limitation has been found to be indefinite and has been interpreted to be the linking of

the standardized message to the actual transaction (amount and account number). A

record of each transaction (account number and amount, etc.) and the standardized

codes (that identify the kind of transaction) are transmitted as claimed. The sorting of

the transaction by the accounting system 52 is satisfied when the transaction is linked to

the correct account. This is a sorting of all transactions that are received because they

must be credited/debited to the correct account. An accounting statement is produced

as claimed, see column 7, lines 60-63; column 10, lines 24-43; column 14, lines 3-6;

and column 15, lines 47-54. A communication network 56 and/or 62 is used for the

transmission of the transaction data.

For claims 31,37,73,111, reciting that the codes are itemization codes is still just

reciting a code. The name that a code is called does not define anything but a code. A

code is a code and simply represents a particular variable or thing. Because Lawlor has

codes and transmits codes as claimed, the codes are considered to satisfy "itemization

codes".

For claim 32, the codes inherently come from a menu as claimed. The menu is

the entire list of available codes that the system could use during processing of the

transactions.

For claims 39,40, the claimed means for providing codes is in Lawlor. Because

the codes are used by the ATM network they inherently must have been provided at

some point. The means for conducting the transactions is the POS nodes (terminals

54). The means for associating the codes is considered to be software that associates

the codes to the transaction. The means for transmitting is the modem/network that is

used to transmit the data. The means for sorting is the processor of computer 52. The

processor takes in transaction data and links it to the correct account so that an

accounting statement can be produced (on paper or by electronic display).

For claims 41,42, reciting what the codes are called does not further define anything about the claimed apparatus. The codes are simply data that is used by the apparatus and the codes are not part of the apparatus, so these claims define nothing further to the claimed apparatus from that recited in claim 39.

For claim 43, applicant is reciting a method step directed to the intended use of the apparatus. This defines no structure to the apparatus and because the system of Lawlor can do what has been claimed, Lawlor anticipates what is claimed.

For claim 45-51,53,58-60,83-89,91,96-98, Lawlor discloses a system as claimed. Lawlor discloses a financial accounting computer 52 (has more than one file) and a plurality of transaction computers 54. The network is 56 and/or 62. The means for providing access to the file is taken to be the security function of Lawlor that requires users to identify themselves by the use of account numbers and a PIN. This is a means to provide access as claimed. With respect to the language directed to the intended use of the system, Lawlor satisfies what has been claimed. A user and/or agent can enter data inputs (a new financial transaction such as a transfer of funds or a bill payment), process the data by reviewing the data, adjusting data (changing the amount of a periodic bill that is automatically paid), and deleting data (informing the bank of an incorrect charge that you did not make and having it corrected). A user can perform any and all of the recited functions.

For claims 52,90, the means for transferring as best understood by the examiner is the network 56 and/or 62.

For claims 54,92, applicant is reciting a method step directed to the intended use of the apparatus. This defines no structure to the apparatus and because the system of Lawlor can do what has been claimed, Lawlor anticipates what is claimed.

For claims 55-57,93-95, reciting what the codes are called does not further define anything about the claimed apparatus. The codes are simply data that is used by the apparatus and the codes are not part of the apparatus, so these claims define nothing further to the claimed apparatus from that recited in claim 45.

For claims 74-76,112-114, Lawlor satisfies what has been claimed. A user and/or agent can enter data inputs (a new financial transaction such as a transfer of funds or a bill payment), process the data by reviewing the data, adjusting data (changing the amount of a periodic bill that is automatically paid), and deleting data (informing the bank of an incorrect charge that you did not make and having it corrected). A user can perform any and all of the recited functions.

For claims 80,81,118,119, Lawlor discloses the claimed apparatus. Lawlor discloses a means for establishing a file on the financial accounting computer 52, which is the save function of the computer that allows files to be saved and data to be saved to the files. The means to establish data inputs is the input function of the terminals 54 that take in transaction data that is to be transferred to the accounting computer 52 via a communication network. The means for providing access to the file is taken to be the security function of Lawlor that requires users to identify themselves by the use of account numbers and a PIN. This is a means to provide access as claimed. The means for generating an accounting statement is the software that allows the data to be

viewed such as in an account statement or in any of the financial data services

disclosed in column 7, lines 60-63; column 10, lines 24-43; column 14, lines 3-6; and

column 15, lines 47-54.

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 44,82,120, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Lawlor et al. (5220501). Lawlor discloses the invention substantially as claimed as

set forth in the 102 rejection. Lawlor does not disclose that the instructions are

contained in a signal in a carrier wave. The signal and carrier wave are essentially a

kind of storage medium that would allow the instructions to be sent electronically to

another computer, such as another Bank branch office. It would have been obvious to

one of ordinary skill in the art at the time the invention was made to put the instructions

as claimed into a signal in a carrier wave so that the instructions could be electronically

transmitted to another computer, such as another accounting computer for a new Bank

branch office, so that the new Bank office can practice the method of Lawlor.
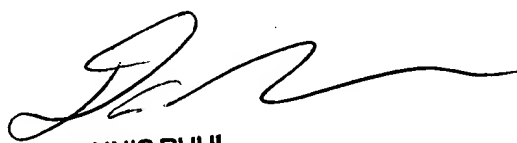

12.   Applicant's arguments with respect to claims 28-120 have been considered but

are moot in view of the new ground(s) of rejection.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER